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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,301	07/18/2003	David P. Walters	Walters - 1	3434

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EXAMINER

COMPTON, ERIC B

ART UNIT PAPER NUMBER

3726

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,301

Applicant(s)

WALTERS ET AL.

Examiner

Eric B. Compton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 12-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/18/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to a caliper retracting tool, classified in class 29, subclass 239.
 - II. Claims 12-24, drawn to a method for retracting a caliper, classified in class 29, subclass 426.5.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus does not necessarily need to be use to retract a caliper, but could be used to as a puller device. See e.g., U.S. 4,406,182 (showing the same structure as claim 1, but used for a different method than claim 12).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Walter Tencza on July 23, 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 12-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

5. Claim 4 is objected to because of the following informalities: in line 3, either "rod" should read –rods—or –rod should be inserted after "second." Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

Applicant appears to claim a complete apparatus, rather than merely a component thereof. See Claim 1 preamble. With regards to claim 1, the omitted element(s) are: force transmitting means for transmitting force to press back at least one piston, e.g., push plate (83), and a force applying means, e.g., fourth rod. Applicant invention seeks to press back at least one caliper piston. Thus, the invention requires these element that transmits force to the caliper, which are only required in later claims.

Claims 2-11 depend from claim 1 and therefore are also indefinite.

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8. Claims 5-8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 5-6, the third and fourth plates, as understood by the Examiner, are plate (70) and plate (72), respectively. The relationship of the first, second, and third plates are established by claims 1-4, that is first and second in a fixed relationship by second and third rods, with the third plate there between. However, it is not clear the structural relationship of the fourth plate with the third plate by claim 5, alone. Only in claim 6 is this established.

Regarding claims 7-8, it is believed that the fourth, fifth, and sixth rods are used to fix the handle assembly with the first plate, rather than the second plate. First rod (30) is connected to plate (34), as required by claim 2. Fourth, fifth, and sixth rods (65-67) connect plate (34) to cam plate (44). Cam plate (44) is believed to be the first plate. Therefore, there is an ambiguity as to the structural relationship of the first rod with the fourth, fifth, and sixth rod. Applicant is requested to resolve this issue.

Claims 6-8 depend from claim 5 and therefore are also indefinite.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. 3,193,915 to Gillie et al ("Gillie").

Regarding claim 1, Gillie disclose an apparatus, comprising a first rod (76); a second rod (88); and a third rod (88), wherein the first rod is connected to the second and third rods so that when the first rod moves the second and third rods also move.

Regarding claim 2, Gillie provides a first plate (80), wherein the first rod, the second rod and the third rod are connected to the first plate.

11. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. 4,406,182 to Antone.

Regarding claim 1, Antone disclose an apparatus, comprising a first rod (36); a second rod (34); and a third rod (34), wherein the first rod is connected to the second and third rods so that when the first rod moves the second and third rods also move.

Regarding claim 2, Antone provides a first plate (16), wherein the first rod, the second rod and the third rod are connected to the first plate.

Regarding claim 3, Antone provides a second plate (32), wherein the second plate is connected to the second rod and the third rod.

12. Claims 1, 9 and 11, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. 6,378,185 to Ratchovsky et al ("Ratchovsky").

Regarding claim 1, Ratchovsky disclose an apparatus, comprising a first rod (42); a second rod (40); and a third rod (51), wherein the first rod is connected to the second and third rods so that when the first rod moves the second and third rods also move.

Regarding claim 9, Ratchovsky provides a handle assembly (22, 23) connected to the first rod (42), wherein a portion of the handle assembly can be squeezed to cause the first rod to move in a first direction which causes the second and third rods to move also in the first direction.

Regarding claim 11, Ratchovsky disclose the handle assembly a trigger release device (23) which if activated after the first rod has moved in the first direction causes the first rod to move in a second direction which is opposite the first direction.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillie.

Gillie discloses second and third rod (88) contact surface (22) of the pan (14). However, the reference does not disclose a second plate.

Regarding claim 3, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a second plate connected to

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the second and third rods of Gillie, in order to more evenly distribute force to the contact surface.

Regarding claim 4, Gillie provides a third plate (46), wherein the second and third rods slide through first and second openings of the third plate.

15. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Antone or Ratchovsky.

Both Antone and Ratchovsky discloses providing a biasing spring on at least one rod to counteract the direction of movement.

Regarding claim 10, it would have been obvious to one having ordinary skill in the art to have provided either Antone or Ratchovsky with a biasing spring on the second and third rods, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co, v. Bemis Co.*, 193 USPQ 8.

Allowable Subject Matter

16. Claims 5-8 and would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

17. Regarding claim 5, the following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or suggest a caliper retraction tool comprising: first, second, third, and fourth rods; first, second, third and

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fourth plates, in the structural relationship claimed, in combination with the other claimed subject matter.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (703) 305-0240. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter B. Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric Compton
Patent Examiner
A/U 3726